

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Prem S. PAUL <i>et al.</i>)	Group Art Unit: 1648
Application No.: 10/618,779)	Examiner: Myron G. HILL
Filed: July 15, 2003)	Confirmation No.: 5988
For: POLYNUCLEIC ACIDS ISOLATED)	
FROM A PORCINE REPRODUCTIVE)	
AND RESPIRATORY SYNDROME)	
VIRUS (PRRSV) PROTEINS)	
ENCODED BY THE POLYNUCLEIC)	
ACIDS, VACCINES BASED ON THE)	
PROTEINS AND/OR POLYNUCLEIC)	
ACIDS)	

**RESPONSE TO NOTICE OF [ALLEGEDLY] NON-COMPLIANT AMENDMENT
AND COMMUNICATION TO THE EXAMINER**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the "Notice of Non-Compliant Amendment" ("the Notice") mailed July 24, 2006, Applicants respectfully submit that the Notice issued **in error** and request that the application immediately be returned to Examiner Hill for further prosecution. Specifically, Applicants wish to draw the Office's attention to the following facts:

1. The allegedly "non-compliant amendment" was **not an Amendment**. Instead, the July 14, 2006, submission, was a **RESPONSE TO ELECTION/RESTRICTION REQUIREMENT** and was identified as such. "Amendment" does not appear in the July 14, 2006, submission.
2. As set forth by the PTO's guidelines on the revised amendment practice (attached as Exhibit A), a claim listing is required in "[a]ny **amendment** document that includes a change to an existing claim, cancellation of an

existing claim or addition of a new claim.” *See Exhibit A, Page 2, Item A5* (emphasis added). Put differently, “**a complete claim listing is only required whenever changes are made to any claims.**” *Id. at Item A10* (emphases added).

3. Because the July 14, 2006, submission did **not** change any of the claims, did **not** cancel any claims, and did **not** add any claims, a complete claim listing was not necessary.


In light of the foregoing, Applicants respectfully request that the Notice be expunged from the application and that the application immediately be returned to Examiner Hill for further prosecution.

However, in an abundance of caution and so as to not delay the substantive prosecution of this application any further, Applicants provide herewith a substitute Response to Restriction Requirement, which contains a listing of the claims. Examination of this application with special dispatch, particularly in light of the pending Request for Interference, is respectfully requested.

In the event there are any questions related to this Response and Communication, Applicants’ undersigned representatives may be reached locally at (202) 373-6000.

Respectfully submitted,
BINGHAM MCCUTCHEN, L.L.P.

Date: August 11, 2006

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